



*STW*

**CERTIFICATE OF MAILING  
UNDER 37 CFR 1.8**

**Date of Deposit: March 17, 2005**

I hereby certify that the following RESPONSE TO RESTRICTION REQUIREMENT along with its enclosures is being deposited with the United States Postal Services with sufficient postage as first class mail on the date indicated above, addressed to:

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Title: FINE-ADJUSTEMENT MECHANISM TO PRESET A MITER SAW  
FOR PRECISION MITER CUTS

Inventor(s): Romo et al.

Application No.: 10/702,332

Filed: November 6, 2003

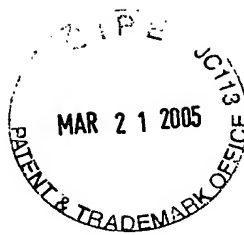
Enclosed:

1. Transmittal Form PTO-1083 (1 pg) and duplicate thereof (1 pg)
2. Response to Restriction Requirement (3 pgs)
3. Return postcard

\_\_\_\_\_  
Typed or Printed Name

*J. M. Kitiouk*  
\_\_\_\_\_  
Signature

Attorney Docket No. **P1484CIP**  
Client No. 066901-1484



In re Application of: Romo et al.  
 Application No. 10/702,332  
 Filed: November 6, 2003  
 For: FINE-ADJUSTMENT MECHANISM TO PRESET A MITER SAW FOR PRECISION MITER CUTS

**Mail Stop Amendment**  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, Virginia 22313-1450**

Sir:

Transmitted herewith is response to a Restriction Requirement in the subject application.

☐ Applicants claim small entity status of this application under 37 CFR 1.27.

☒ Petition For Extension Of Time

☐ Applicants petition for a extension of time under 37 CFR 1.136, the fee for which is \$ (enclosed).

☒ Applicants believe that no petition for an extension of time is necessary. However, to the extent that such petition is deemed necessary, Applicants hereby petition for a sufficient extension of time to render the present submission timely. Please charge Deposit Account No. 07-0181 for the appropriate petition fee.

☒ No additional claim fee is required.

☐ Other:

The claim fee has been calculated as shown below:


|                          |                                      |       |                                    |                      | SMALL ENTITY |                 | OTHER THAN A SMALL ENTITY |                 |
|--------------------------|--------------------------------------|-------|------------------------------------|----------------------|--------------|-----------------|---------------------------|-----------------|
|                          | CLAIMS REMAINING AFTER AMENDMENT     |       | HIGHEST NUMBER PREVIOUSLY PAID FOR | EXTRA CLAIMS PRESENT | RATE         | ADDIT CLAIM FEE | RATE                      | ADDIT CLAIM FEE |
| TOTAL                    | 29                                   | MINUS | 29                                 | =0                   | x \$25=      | \$              | x \$50=                   | \$0.00          |
| INDEPENDENT              | 5                                    | MINUS | 5                                  | =0                   | x \$100=     | \$              | x \$200=                  | \$0.00          |
| <input type="checkbox"/> | FIRST PRESENTATION OF MULTIPLE CLAIM |       |                                    |                      | + \$180=     | \$              | + \$360=                  | \$0.00          |
|                          |                                      |       |                                    |                      | TOTAL        | \$              | TOTAL                     | \$0.00          |

- ☐ Please charge my Deposit Account No. 07-0181 in the amount of \$ . A duplicate copy of this sheet is attached.
- ☐ A check in the amount of \$
- ☒ The Commissioner is hereby authorized to charge any deficiencies in the following fees associated with this communication or credit any overpayment to Deposit Account No. 07-0181. A duplicate copy of this sheet is attached.
- ☒ Any filing fees under 37 CFR 1.16 for the presentation of extra claims.
- ☒ Any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

GARDNER CARTON & DOUGLAS LLP

By

  
 Thomas A. Belush, Reg. No. 37,090  
 One of the Attorneys for Applicant(s)

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**PATENT**  
Attorney Docket No. P 1484CIP

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Romo et al.

Art Unit: 3724

Application No. 10/702,332

Examiner: Prone, Jason D.

Filed: November 6, 2003

For: FINE-ADJUSTMENT MECHANISM  
TO PRESET A MITER SAW FOR  
PRECISION MITER CUTS

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

The present submission is in response to the Office Action dated February 17, 2005. The Office Action sets forth a restriction and requires the election of one of two species. Particularly, the Examiner stated that Species I is shown in FIGS. 1-8, and Species II is shown in FIGS. 9-20.

Applicants provisionally elect, with traverse, Species II (FIGS. 9-20). The following claims read upon the elected species: 1, 2, 4, 6-9, 11-21, 23-27, and 29.

M.P.E.P. § 804 (f) requires that claims to be restricted to different species must be mutually exclusive. M.P.E.P. § 804 (h) further requires that species subject to a restriction must be patentably distinct from each another. The Patent Office has made no effort to establish that claims are mutually exclusive or that the species are patentably distinct, yet the Office Action imposes a burden on Applicants to establish that the species are not.

Applicants traverse the restriction on the basis that the Patent Office has failed to establish that an examination of all pending claims would be seriously burdensome for the Examiner. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803: **"If the search and examination of an entire**

In re Appln. Of Romo  
Application No. 10/702,332

**application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.**


In the case at hand, the Patent Office has failed to meet the criteria for a proper restriction requirement by not even so much as asserting that there would be a serious burden on the Examiner if the election of species were not required. For example, the Patent Office has failed to demonstrate or even allege that an examination of claims of the two species would require searches under different classifications. Without even the slightest attempt by the Office to satisfy the first criterion for a proper restriction requirement, it can not be said that a search directed to all or some combination of the groups of claims would amount to an undue burden in satisfaction of the second criterion for a proper restriction requirement.

Furthermore, the Office Action cites 37 C.F.R. § 1.121 as the authority for the restriction. Applicants respectfully submit that the cited regulation does not appear to pertain to restriction practice.

Therefore, in the instant case, the requirements for restriction and election of species are not proper. Applicants respectfully request the withdrawal of the requirements and examination of all the pending claims.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Thomas A. Belush, Reg. No. 37,090  
One of the Attorneys for Applicant(s)  
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Customer No.: 08968

Date: March 17, 2005

In re Appln. Of Romo  
Application No. 10/702,332

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Date: March 17, 2005

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CH02/ 22374090.1